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EXAMINER
ABDELSALAM, FATHI K

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3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *19 December 2008*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,7,8,10,12,16 and 18-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 7, 8, 10, 12, 16, and 18-31* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is a non-final, first office action on the merits in response to

applicant's communication filed on 12/19/2008. Applicants have amended claims 1, 7,

8, 10, 12, 16, and 18. Applicants have cancelled claims 2-6, 9, 11, 13-15, and 17. Also,

Applicants have added new claims 19-31. Therefore, claims 1, 7, 8, 10, 12, 16 and 18-

31 are currently pending.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 1, 7, 8, 10, 12, 16, and 18-27 are rejected under 35 U.S.C. 101 based on

Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must (1) be tied to another statutory class (such as a

particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70

(1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

       An example of a method claim that would <u>not</u> qualify as a statutory process

would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

process, the claim should positively recite the other statutory class (the thing or product)

to which it is tied, for example by identifying the apparatus that accomplishes the

method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1, 7, 8, 10, 12, 16 and 18-27 do not positively recite another statutory class to which the method steps are tied and therefore are non-statutory.

Despite the description "via a graphical user interface" in claim 1, the method is neither sufficiently tied to a statutory class nor transforming the underlying subject-matter. None of the limitations of claim 1 necessitate a processor, so the limitations are merely a series of mental steps which could be performed manually as well as on a processor. Likewise, the subsequent depending claims fail to add any substance that bring them in compliance with § 101, so they do not comply for the same reasons.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

Claims 1 and 28 recite: "treating two or more information systems as a single

logical information system to execute pre-change due diligence"—examiner is unclear

on how the motion of "treating" something enables that thing to execute anything?

Examiner would appreciate if applicant would elucidate on how the "treating of the two

or more information systems" affects the end structure of whatever system the process

is necessarily/statutorily tied and furthermore, how said executing is enabled thereof.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 7, 10, 16, 18-25, and 28-31 are rejected under under 35 U.S.C. 103(a)

as being unpatentable over Sanches (US PG PUB 2003/0018510), in view of Freitag

(US Patent 7069192).

8.   Regarding **Claim 1**:

Sanches discloses a method of facilitating enterprise change comprising:

treating two or more information systems as a single logical information system

to execute pre-change due diligence and post-change integration of the enterprise

change, wherein the enterprise change is at least one of a merger and acquisition ("One

exemplary use of MECA is the integration of mergers and acquisitions" [0062]);

Identifying a synergy ("MECA enables management to achieve more revenue

and cost synergy targets" [0037]). See Also ("The present invention manages the

deployment, execution, and tracking of initiatives. "Initiatives" means coordinated non-

routine efforts of large number of individuals and entities (up to many thousands or even

more), for example, in an extended organization. Examples include, without limitation,

regulatory compliance initiative, institution of new policies or practices, retraining

projects, product launches, mergers and acquisitions" [0030]);

Conducting a synergy via a graphical user interface ("MECA, in one embodiment

of the present invention, is an integrated, Web-based platform designed to manage all

facets of initiative execution. Executive teams can simultaneously manage any number

of critical initiatives, of any size. Via MECA's easy-to-use Web interface, users create,

browse and manage action plans, team structures, and reports" [0055]);

creating at least one comparison of the synergy against a synergy target for the

synergy by measuring the synergy against the synergy target ("Auto-calculate and

compare actual performance to strategic objective targets" [0047]).

But, Sanches does not explicitly disclose the method capturing a history of

changes. However, Freitag teaches: capturing a history of the enterprise change and

applying the history to at least one subsequent enterprise change to achieve a

subsequent synergy in the at least one subsequent enterprise change ("generates

collaboration logs 7 as shown in FIG. 4. These contain such information as the name of

the person making the changes, the date and time of the change, a status indicating if

all members of the session agreed on the change, the location of the person making the

change, a description of the method used to perform the change, a complete description

of all parameters to be applied to the method used to perform the design change" [col.

7, line 34]).

      Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to have modified the method of Sanches so as to have included

change-log functionality, as taught by Freitag, in order to provide for an up to date

synergy based on histories, since so doing could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of

unexpected results.

      In **KSR**, the Supreme Court particularly emphasized "the need for caution in

granting a patent based on the combination of elements found in the prior art," and

discussed circumstances in which a patent might be determined to be obvious.

Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he

combination of familiar elements according to known methods is likely to be obvious

when it does no more than yield predictable results." In this case the combination of a

method of facilitating enterprise change disclosed by Sanches and history of change-

logs disclosed by Freitag would yield a predictable result, specifically a method of

synergistic change including the use of historical change logs. It would have been

obvious to one of ordinary skill in the art to modify Sanches' method to include said log

functionality of Freitag because the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same

function as it did separately. Furthermore one of ordinary skill in the art would have

recognized that the results of the combination were predictable, therefore the

combination has been deemed obvious.

9.   Regarding **Claim 7**:

        Sanches discloses the method of claim 1, wherein the graphical user interface

further comprises:

        a scale of measurement for the synergy, and ("MECA is used when the value of

compliance can be at least roughly quantified, and where compliance in the action is

potentially as important to the organization as compliance with other mandatory

systems for financial reporting, HR and account management" [0155]). See also ("In

preparing MECA for action, in one embodiment, managers use MECA Web interface to

define: team structures; action plans (can also import from MS Project or other project

planning tool); notifications and key communications; interactive action items;

performance metrics and other business rules" [0059]). See also, ("As the strategic

benefit, MECA maximizes and accelerates returns from strategic initiatives. In post-

merger integration, for example, MECA enables management to achieve more revenue

and cost synergy targets, and to achieve them more rapidly, predictably, and

completely" [0037]); and

a selector for approval of the synergy ("TaskState.ACTIVE (meaning that the task is ready to be started or has started and is accepting fulfillments)" [0297]). See also ("task 210 he may accept or reject" [0320]).

10.   Regarding **Claim 10**:

Sanches discloses the method of claim 1, wherein the graphical user interface further comprises:

a panel adapted to present merger-related views ("Manage data. View real-time reports on status, progress, outcomes Auto-calculate and compare actual performance to strategic objective targets" [0047]).

11.   Regarding **Claim 16**:

Sanches discloses the method of claim 1, further comprising:

Conducting at least one of an approval action, a rejection action ("task 210 he may accept or reject" [0320]). See also ("generating an action plan including action items to accomplish the initiative tasks" [Abstract]);

a cancellation action ("As roles change, MECA automatically initiates, cancels or retargets action items and communications" [0058]); and

a storing action via an action interface ("an action management database for storing a dynamically generated organizational model" [0011]). See Also ("MECA, in one embodiment of the present invention, is an integrated, Web-based platform designed to manage all facets of initiative execution. Executive teams can

simultaneously manage any number of critical initiatives, of any size. Via MECA's easy-

to-use Web interface, users create, browse and manage action plans, team structures,

and reports" [0055]).

12.   Regarding **Claims 18**:

Sanches discloses the method of claim 1 wherein the graphical user interface

further comprises:

Conducting at least one of a sales integration ("In post-merger integration, for

example, MECA enables management to achieve more revenue and cost synergy

targets, and to achieve them more rapidly, predictably, and completely" [0037]);

an account transition ("Implement hundreds of procedural changes and dozens

of IT transitions" [0265]), file sharing, and

discussions ("Use MECA to centrally capture and communicate strategic

objectives" [0039]). See also ("Manage task communication & delivery. Use MECA's

form-builder to quickly create closed-loop mass communications and interactive "mass

action items" that are embedded directly in transition plans" [0042]);

via an integration interface, and wherein integration interface features include at

least one of a checklist for integration issues, and a panel for generating a document

request ("MECA's easy-to-use Web interface, users create, browse and manage action

plans, team structures, and reports" [0055]).

13.   Regarding **Claim 19**:

Sanches discloses the method of claim 18 wherein the integration interface includes features for viewing at least one of deliverables ([0037], "MECA enables management to achieve more revenue and cost synergy targets [i.e. deliverables] "), and calendars ([0208], "Action management teams 20 may typically be composed of: (1) Action directors (AD) who define an action in business terms: desired outcomes, time-frames [calendar]").

14.   Regarding **Claim 20**:

Sanches discloses the method of claim 1 wherein the synergy is at least one of a value, performance, and effect that can be achieved wherein resources of at least two enterprises combined will be greater than a sum of the resources of the at least two enterprises individually ("In one embodiment, the present invention provides MECA (Managed Enterprise Communications Command and Control Architecture), implemented by a hosted software tool that allows management to direct and measure the success of acquisitions and other high value, large scale initiatives" [0033]).

15.   Regarding **Claim 21**:

Sanches discloses the method of claim 1 wherein the synergy is based on, at least in part, at least one of: a human resources group, one or more customers, one or more suppliers, one or more sales, one or more services, one or more organizational departments, one or more information technology issues, and one or more budgets ("An acquiring company's post-merger strategy may include consolidating all process,

objectives, resources, and responsibilities of the two organizations: Processes. Sales

practices, customer service standards, fulfillment and delivery methods, IT system

operating procedures, engineering methodologies, human resource policies and

procedures" [0161-0162])

16.   Regarding **Claim 22**:

        Sanches discloses the method of claim 1 wherein the synergy further comprises:

        achieving business goals ("MECA enables management to achieve more

revenue and cost synergy targets" [0037]). See also ("ingredients of acquisition success

are rapid integration of the acquired company, and universal understanding and buy-in

of strategic objectives. The MECA action management platform is tailor-made to

achieve both objectives" [0159]); and

        assisting customers during the enterprise change ("action design (or planning)

assistance" [0200]). See also ("When interacting with MECA via telephone auto-

attendant, participants may enter a key such as "0" to connect to an Action Support

Team 40 member for live assistance" [0229]).

17.   Regarding **Claim 23**:

        Sanches discloses the method of claim 1 wherein the subsequent synergy in the

at least one subsequent enterprise change is achieved using a closed-loop feedback

("Real-time feedback on progress, compliance rates, and outcomes allows management

to make mid-course corrections to keep the initiative on track" [0036]). See also ("For an

urgent or key action item, rather than send repeated e-mail messages, the notification

sequence may escalate to a phone call (i.e., a different communication media is used)

from a support team 40 member" [0221])—the phone call representing a closed-loop

feedback. See also ("Therefore, there is a need to close the loops between a relatively

small number of managers and an arbitrarily large number of participants in the

initiative" [0094])

18.   Regarding **Claim 24**:

        Sanches discloses the method of claim 23, along with making comparisons for

synergistic objectives ("Auto-calculate and compare actual performance to strategic

objective targets" [0047]).

        But, Sanches does not explicitly disclose the method relaying a comparison from

a history of changes. However, Freitag teaches a method wherein the closed-loop

feedback further comprises:

        relaying the at least one comparison from the history to a subsequent graphical

user interface associated with the subsequent synergy in the at least one subsequent

enterprise change; and applying the at least one comparison to the at least one

subsequent graphical user interface to achieve the at least one subsequent enterprise

change ("generates collaboration logs 7 as shown in FIG. 4. These contain such

information as the name of the person making the changes, the date and time of the

change, a status indicating if all members of the session agreed on the change, the

location of the person making the change, a description of the method used to perform

the change, a complete description of all parameters to be applied to the method used
to perform the design change" [col. 7, line 34]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the
time of the invention, to have modified the method of Sanches so as to have included
change-log functionality, as taught by Freitag, in order to provide for an up to date
synergy based on histories, since so doing could be performed readily and easily by any
person of ordinary skill in the art, with neither undue experimentation, nor risk of
unexpected results.

In KSR, the Supreme Court particularly emphasized "the need for caution in
granting a patent based on the combination of elements found in the prior art," and
discussed circumstances in which a patent might be determined to be obvious.
Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he
combination of familiar elements according to known methods is likely to be obvious
when it does no more than yield predictable results." In this case the combination of a
method of facilitating enterprise change disclosed by Sanches and history of change-
logs disclosed by Freitag would yield a predictable result, specifically a method of
synergistic change including the use of historical change logs. It would have been
obvious to one of ordinary skill in the art to modify Sanches' method to include said log
functionality of Freitag because the claimed invention is merely a combination of old
elements, and in the combination each element merely would have performed the same
function as it did separately. Furthermore one of ordinary skill in the art would have

recognized that the results of the combination were predictable, therefore the

combination has been deemed obvious.

19.   Regarding **Claim 25**:

Sanches discloses the method of claim 10 wherein the panel adapted to present

merger related views further comprises at least one of:

a link to a file space view; a link to a methodology view; a link to a view of

research; a link to a view of reports; and a link to a view of a merger log; See ("MECA

dynamically links people, plans, & action performance in a single, Web-based,

execution framework" [0049]) in conjunction with ("View real-time reports on status,

progress, outcomes Auto-calculate and compare actual performance to strategic

objective targets" [0047]).

20.   Regarding **Claims 28-31**:

Claims 28, 29, 30, and 31 recite substantially similar limitations to claims 1, 20,

22, and 23, respectively, and are therefore rejected using the same art and rational set

forth above.

Sanches further discloses a computer program product residing on a computer

readable medium having a plurality of instructions stored thereon which, when executed

by a processor, cause the processor to perform operations ("the present invention

provides a computer readable medium having program code recorded thereon for

planning and managing an initiative, the program code configured to cause a computing

system to perform the following steps" [0010]).

21.   **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Sanches (US PG PUB 2003/0018510), in view of Freitag (US Patent 7069192), and

in further view of Minow et al. (US PG PUB 2003/0225652), hereinafter referred to

as Minow. The references disclosing the functionality of Sanches and Freitag

have been set forth above.

22.   Regarding **Claim 8**:

        Sanches discloses the method of claim 1, wherein the graphical user interface

further comprises:

        at lease one synergy target ("MECA enables management to achieve more

revenue and cost synergy targets" [0037]);

        at least one sub-deliverable ("adjusting the timing, sequence, or targeting of

individual or collective tasks based on those outcomes" [0031]).

        But, Sanches does not explicitly disclose that the method accounts for at least

one risk.

        However, Minow teaches a system as above utilizing a risks section ("Board

scores may be correlated with performance scores in the manner illustrated in Table 2,

below, to arrive at overall, forward-looking, investment and risk-oriented letter grades"

[0067]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system and method of Sanches so as to have included utilizing a risks section, as taught by Minow, in order to improve the efficiency of the system, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

23.   **Claim 12, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US PG PUB 2003/0018510), in view of Freitag (US Patent 7069192), and in further view of Adhikari (US PG PUB 2004/0158479). The references disclosing the functionality of Sanches and Freitag have been set forth above.**

24.   Regarding **Claims 12, 26, and 27**:

Sanches discloses the method of claim 1; but, Sanches does not explicitly disclose the following elements that Adhikari disloses below:

Adhikari teaches:

a financial checklist interface adapted to present a financial checklist and wherein the financial checklist further comprises at least one of: a risk checklist item; a synergy checklist item; a list of legal data checklist item; a list of accounting data checklist item; and a list of internal data checklist items, wherein the internal data comprises proprietary information ("Enabled Advanced Features cells are marked with a square

button with an "A" inside. Clicking the "A" icon associated with the following input data

set element cells prompts the system to display new pop-up screens; Sales Growth and

EBITDA Growth 116, EBITDA Synergy 120, Capital Expenditure 118, Accounts

Receivable 96, Inventory 100, Accounts Payable 108, Additional Equity 206" [0088]);

and

the financial checklist interface including at least one button configured to add or

delete an item to or from the financial checklist and using the financial checklist to

generate a synergy ("a square button with an "A" inside...EBITDA Synergy 120" [0088]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to have modified the method of Sanches so as to have included

utilizing a financial checklist and an interface including a button, as taught by Adhikari,

in order to improve upon the efficiency of the system, since so doing could be

performed readily and easily by any person of ordinary skill in the art, with neither undue

experimentation, nor risk of unexpected results.

Response to Arguments

26.   Applicant's arguments filed 12/19/2008 have been fully considered but they are

not persuasive. Applicant's arguments with respect to claims 1, 7, 8, 10, 12, 16 and 18

have been considered but are moot in view of the new ground(s) of rejection under 35

U.S.C. 103(a) in which many of the arguments stemming from the applicants have been

answered and further elucidated in view of the prior art incorporated herein.

Conclusion

27.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

28.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Fathi Abdelsalam whose telephone number is (571)

270-3517. The examiner can normally be reached on Monday to Thursday 8:00-

5:00pm ET.

29.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

30.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A./
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
4/6/09